

### REMARKS

Claims 1, 8-11, 13-18, 20-23, and 26-29 are pending, of which claims 1 and 29 are independent. Claim 1 has been amended. Claims 26 and 27 have been canceled. Claim 29 has been added.

Claim 18 was withdrawn in response to a restriction requirement, but in order to retain the right to rejoinder, Applicant amended claim 18 to depend from claim 1, thus requiring all the limitations of the elected invention (as directed by MPEP § 821.04).

#### 35 U.S.C. 112 Rejections

Claims 1, 8-11, 13-17, 20-23, and 26-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. While Applicant does not agree that these claims lack written description under 35 U.S.C. 112, first paragraph, Applicant has amended claim 1 to remove the language objected to by the Examiner, and claims 26 and 27 have been canceled.

#### Prior Art Rejections

Claims 1, 8-11, 13-17, and 20-23, and 26-28 stand rejected as follows. Claims 1, 9-11, 15-17, 21, 22, and 27 stand rejected under 35 U.S.C. 102(b) as anticipated by Kern (U.S. 4,601,545). Claims 8, 13, 14, 23, and 28 stand rejected under 35 U.S.C. 103(a) as unpatentable over Kern in view of Rizzo (U.S. 5,800,530). Claim 20 stands rejected under 35 U.S.C. 103(a) as unpatentable over Kern in view of Sandsted (U.S. 6,749,632). Claim 26 stands rejected under 35 U.S.C. 103(a) as unpatentable over Kern in view of Nelson (U.S. 7,127,299).

#### Claim 1

The Examiner has made a clear error in the standard used to support the 35 USC 102(b) rejection of claim 1. In view of this error, Kern fails to disclose all limitations of independent claim 1. Thus, Kern fails to support a *prima facie* 35 USC 102(b) rejection of claim 1.

Applicant submits that Kern neither discloses nor suggests at least that “the wavefront data is configured according to a selected a high-order aberration correction to modify the characteristic function of the optical element to reduce high-order aberration in the eye,” as recited by claim 1.

In the pending Office Action, as in the previous Office Actions, the Examiner is interpreting the RAM or ROM in the CPU 54 as the recited “memory element,” and the “instructions regarding distribution of voltage levels” as the recited “wavefront data.” The Examiner refers to col. 5, lines 45-47 as disclosing an “aspheric lens effect ... which reduce high order, or spherical, aberration.”

The Examiner is interpreting the phrase “the wavefront data is configured according to a selected a high-order aberration correction” as reading on the instructions stored in the memory of Kern because the electrodes of Kern correct a selected high-order aberration. It appears that the Examiner is making an argument that Kern inherently discloses that the instructions stored in the memory are configured according to a selected high-order aberration correction, as Kern does not explicitly disclose that the instructions stored in the memory are configured according to any aberration correction, much less, a “selected a high-order aberration correction.”

Applicant respectfully points out that “to establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In Kern, not only are there other possibilities for configuring the instructions in the memory besides “according to a selected high-order aberration correction,” as the claim requires, but Kern specifically describes that it is the electrode arrangements that achieve effects such as the “aspheric lens effect” which provide the aberration correction. Thus, Applicant submits that the rejection of claim 1 is based on a clear error in establishing a valid *prima facie* anticipation rejection based on inherency, and requests reconsideration.

*Dependent claims*

The remaining claims are all properly dependent on claim 1, and are thus allowable therewith. The dependent claims add one or more further limitations, which are not presently relied upon to establish patentability. For that reason, and not because Applicant agrees with the Examiner, no rebuttal is offered to the Examiner's reasons for rejecting the dependent claims.

New claim 29

New claim 29 recites that "the wavefront data is configured according to a selected a high-order aberration correction to modify the characteristic function of the optical element to reduce high-order aberration in the eye." Claim 29 is allowable for similar reasons as for claim 1.

\$255 for the Appeal fee is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account Authorization. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 00633-041001.

Respectfully submitted,

Date: June 18, 2008

/Elliott J. Mason, III/  
Elliott J. Mason, III Reg. No. 56,569

Fish & Richardson P.C.  
Telephone: (617) 542-5070  
Facsimile: (877) 769-7945